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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/077,128 | 02/14/2002 | Daniel C. Castle | 10014745-1 | 2893 |
| 7590 | 02/08/2006 | | | |
| | | | EXAMINER | |
| | | | LAM, ANDREW H | |
| | | ART UNIT | PAPER NUMBER | |
| | | | | 2624 |

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/077,128 | CASTLE, DANIEL C. | |
| | Examiner | Art Unit | |
| | Andrew H. Lam | 2624 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 November 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-23 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

DOUGLAS Q. TP
PRIMARY EXAMINER
Douglas Q. Lam

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/13/05 A.L.

- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

- This action is responsive to the following communication: an Amendment filed on 11/14/05.
- Claims 1-23 are pending in the present application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miura et al (U.S. Patent No. 6,862,103) hereinafter Miura in view of Miyasaka et al (U.S. Patent No. 6,766,362) hereinafter Miyasaka.

Regarding claim 1, Miura discloses a system (fig. 9, diagram of the network print system) for generating a personalized publication, comprising: a processor; and a memory, coupled to the processor (fig. 9, client 101 is an information processing apparatus such as a personal computer or the like--inherently personal computer have memory that is coupled to the processor with instruction on how to process tasks), the memory containing instructions that when executed by the processor cause the processor to receive information identifying a background template and a foreground image (col. 10, lines 9-13, the browser is used to send request to the server to retrieve data which is the template and the image data); acquiring the background image from a

network resource (col. 10, lines 30-33, a form template storage unit 108 stores form templates--the server sends an HTML document corresponding to a given form template to the client); acquiring the foreground image from a network resource (col. 10, lines 40-43, data storage unit 109 is a database for storing task data, which is the foreground data that is to be inserted into the template); and merging the background template and the foreground image (col. 13, lines 25-26, the form template and data are merged).

Miura does not disclose expressly a system for accessing a content network resource and locating personalized content of interest to a user based on a profile of previously entered preferences of the user.

Miyasaka discloses a system for accessing a content network resource (col. 3, lines 14-40) and locating personalized content of interest (col. 5, lines 60-65) to a user based on a profile of previously entered preferences of the user (col. 3, lines 60-65).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Miura as per teaching of Miyasaka for the following reason: by having a system that locate personalized content of interest to a user based on a profile of previously entered preferences allow the user to receive the personalized content automatically without having to search for the personalized content.

Regarding claim 2, the combination of Miura and Miyasaka discloses the system of claim 1, wherein the processor further includes means (Miura, fig. 9, network 105, is used to connect the client to the server for acquiring the template and image data) for

connecting to the network resource for acquiring the background template and the foreground 6853461 image.

Regarding claim 3, the combination of Miura and Miyasaka discloses the system of claim 1, wherein the processor further includes a staging area (Miyasaka, fig. 2, layout database 46) for maintaining the merged background template and foreground image (Miyasaka, col.3, lines 1-10).

Regarding claim 4, the combination of Miura and Miyasaka discloses the system of claim 1, wherein the memory further contains instructions that when executed by the processor causes the processor to receive information defining a date for transmitting the merged background template and foreground image to a client (Miyasaka, fig. 5E).

Regarding claim 5, the combination of Miura and Miyasaka discloses the system of claim 4, wherein the processor further includes a delivery area (Miyasaka, fig. 2, deliver 48, col. 3, lines 5-12) for maintaining the merged background template and foreground image before being transmitted in response to the transmission date.

Regarding claim 6, the combination of Miura and Miyasaka discloses the system of claim 1, wherein the instructions when executed by the processor further cause the processor to connect to a transmission medium and transmit the merged background template and foreground image along the transmission medium (Miyasaka, see figs. 2, 3, 4).

Regarding claim 7, Miura discloses a method for generating a personalized publication, comprising:

(a) retrieving a background image including foreground information image (col. 10, lines 9-13, the browser is used to send request to the server to retrieve data which is the template and the image data), the foreground information being identified by a unique identifier (col. 11, lines 29, a URL of the document);

and (c) merging the foreground information and the background image (col. 13, lines 25-26, the form template and data are merged).

Miura does not expressly disclose (b) retrieving content to be maintained as the foreground information, wherein the content is retrieved from a content network resource and is personalized to the interests of a user based on a profile of previously entered preferences of the user.

Miyasaka discloses a method for (b) retrieving content to be maintained as the foreground information, wherein the content is retrieved from a content network resource (see, fig. 2) and is personalized to the interests (col. 5, lines 60-65) of a user based on a profile of previously entered preferences of the user (col. 3, lines 60-65).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Miura as per teaching of Miyasaka for the following reason: by having a system that locate personalized content of interest to a user based on a profile of previously entered preferences allow the user to receive the personalized content automatically without having to search for the personalized content.

Regarding claim 8, the combination of Miura and Miyasaka discloses the method of claim 7, further comprising: (d) storing the merged foreground information and background image in a delivery area (Miyasaka, fig. 2, deliver 48, col. 3, lines 5-12).

Regarding claim 9, the combination of Miura and Miyasaka discloses the method of claim 8, further comprising: (e) delivering the merged foreground information and background image to a requesting location (Miyasaka, fig. 5G, deliver to e-mail abc@xyz.com).

Regarding claim 10, the combination of Miura and Miyasaka discloses the method of claim 9, wherein the requesting location is a client station (Miyasaka, fig. 2, recipient 41).

Regarding claim 11, the combination of Miura and Miyasaka discloses the method of claim 7, further comprising receiving a request for merged information, the request for receiving the merged information being performed before the merging step (Miyasaka, figs. 5a-5g, are preferences being entered before the merging steps, i.e., fig. 5d, content layout).

Regarding claim 12, the combination of Miura and Miyasaka discloses the method of claim 7, wherein the background image comprises a template (Miyasaka, figs. 5D, 8A-8F).

Regarding claim 13, the combination of Miura and Miyasaka discloses the method of claim 7, wherein the foreground information retrieving step comprises: (b1) accessing a user-defined file from a network resource (Miyasaka, fig. 5A); and (b2) storing the user-defined file in a staging area (Miyasaka, fig. 2, layout database 46).

Regarding claim 14, the combination of Miura and Miyasaka discloses the method of claim 13, wherein the user-defined file comprises one of the following: an

image, a comic strip and a quote (Miyasaka, it is well known in the art that newspaper content contains an image, a comic strip and a quote).

Regarding claim 15, the combination of Miura and Miyasaka discloses the method of claim 7, wherein the background image retrieving step further comprises: (a1) accessing a network resource containing a plurality of background images (Miyasaka, figs. 8A-8F); and (a2) retrieving a user-defined background image from one of the plurality of background images (Miyasaka, fig. 5D, user selects the second template); and (a3) storing the user-defined background image in a staging area (Miyasaka, fig. 2, layout database 46).

Regarding claim 16, the combination of Miura and Miyasaka discloses the method of claim 9, wherein the merged foreground information is delivered according to a user-defined schedule (Miyasaka, figs. 5E and 5G).

Regarding claim 17, Miura discloses a method for generating a personalized electronic document, comprising:

(a) receiving information identifying a background template and a foreground image (fig. 2, shows a browser where a user can select the background template and the foreground image);
(b) acquiring the background template from a network resource (fig. 9, form templates storage unit 108 is used to store templates where a user can select to use as the background); and

(c) acquiring the foreground image from a network resource (fig.9, data storage unit 109 is used to store data where a user can select to use to merge with the background).

Miura does not expressly disclose a method for (d) merging the background template and the foreground image, wherein personalized content for the document is retrieved from a content network resource and personalized to the interests of a user based on a profile previously entered preferences of the user.

Miyasaka discloses a method for (d) merging the background template and the foreground image, wherein personalized content for the document is retrieved from a content network resource (col. 3, lines 14-40) and personalized to the interests (col. 5, lines 60-65) of a user based on a profile previously entered preferences of the user (col. 3, lines 60-65).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Miura as per teaching of Miyasaka for the following reason: by having a system that locate personalized content of interest to a user based on a profile of previously entered preferences allow the user to receive the personalized content automatically without having to search for the personalized content.

Regarding claim 18, the combination of Miura and Miyasaka discloses the method of claim 17, further including: (e) receiving a delivery date (Miyasaka, fig. 5E); and (f) delivering the merged document on the delivery date (Miyasaka, fig. 5G).

Regarding claim 19, the combination of Miura and Miyasaka discloses the method of claim 17, wherein the information receiving step further comprises: (a1) receiving a background type identifier (Miyasaka, fig. 5D, select layout); and (a2) receiving foreground image placement information (Miyasaka, figs. 8A-8F, placement of foreground image).

Regarding claim 20, the combination of Miura and Miyasaka discloses the method of claim 19, further comprising: (a3) receiving a foreground image identifier (Miyasaka, figs. 7 and 8A-8F, step 84).

Regarding claim 21, the combination of Miura and Miyasaka discloses the method of claim 17, wherein the foreground image is identified as being one of the following: a comic, an image, a quote (Miyasaka, it is well known in the art that newspaper content contains an image, a comic strip and a quote).

Regarding claim 22, the combination of Miura and Miyasaka discloses the method of claim 19, wherein the foreground image placement information causes the foreground image to be positioned along the top, bottom, or side portions of the background template (Miyasaka, see, figs. 8A-8F).

Regarding claim 23, the combination of Miura and Miyasaka discloses the method of claim 19, wherein the foreground image placement information causes the foreground image to be positioned about the central portion of the background template (Miyasaka, see, figs. 8A-8F).

Response to Arguments

Applicant's arguments, see pages 6-7, filed 11/14/05, with respect to the rejection(s) of claims 1-3m 6-15m 17 and 19-23 under 102(e) and 4, 5, 16 and 18 under 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art references due to newly amended limitations as cited in claims 1, 7 and 17.

Regarding claims 1, 7 and 17, the applicant argued the cited prior art (U.S. Patent No. 6,862,103 to Miura) fail to teach and or/ suggest that "retrieved from a content network resource and personalized to the interests of a user based on a profile of previously entered preferences of the user".

In response to applicant's argument Miyasaka discloses a system for accessing a content network resource (col. 3, lines 14-40) and locating personalized content of interest (col. 5, lines 60-65) to a user based on a profile of previously entered preferences of the user (col. 3, lines 60-65).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Miura as per teaching of Miyasaka for the following reason: by having a system that locate personalized content of interest to a user based on a profile of previously entered preferences allow the user to receive the personalized content automatically without having to search for the personalized content.

Contact Information

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

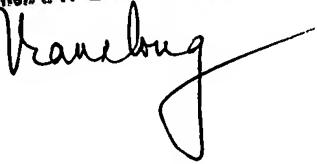
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew H. Lam whose telephone number is (571) 272-8569. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DOUGLAS Q. TRAN
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read "Tranlong".